

## REMARKS

In the Office Action<sup>1</sup> dated May 31, 2006, the Examiner rejected claims 1-15 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application No. 09/795,219 to Walters et al. ("*Walters*")<sup>2</sup>. By this Amendment, Applicants have added claims 16-21. Based on the following remarks, Applicants respectfully traverse the rejection of claims 1-15 under 35 U.S.C. § 102(a), and the timely allowance of claim 1-21.

The Examiner asserts *Walters* anticipates claims 1-15. Applicants respectfully disagree. In order to properly establish that *Walters* anticipates Applicants' claimed invention, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference.

Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

The cited art fails to support a *prima facie* case of anticipation because *Walters* does not disclose each and every element of claims 1-15. For example, claim 1 recites a combination including, for example, "receiving account preference information from the applicant, the account preference information describing the applicant's preferences concerning various features of the financial account product." The Examiner asserts that *Walters* teaches these recitations at paragraphs 0011-0012 and 0018 (Office action

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

<sup>2</sup> Applicants note that *Walters* has a publication date (October 3, 2002) after Applicants' filing date of April 20, 2001. Accordingly, Applicants assume the Examiner intended to reject claims 1-15 under 35 U.S.C. § 102(e) based on *Walters*' filing date of February 27, 2001. Applicants, however, request clarification by the Examiner in the next communication with Applicants.

at p. 2). Applicants respectfully disagree. Instead, *Walters* discloses “a computer readable memory storing a computer program executable by a processor.” The program disclosed by *Walters* comprises:

“a client questionnaire module that presents a first set of questions to a client and receives a first set of answers, presents subsequent sets of questions to the client which are customized based on the answers to the first and other previous sets of questions so that the client is not asked redundant, unnecessary, or inappropriate questions, and receives answers to the subsequent sets of questions, wherein the questions request (A) personal information comprising client and dependent names, ages, and marital status; (B) financial information on one or more of savings accounts, investment accounts, insurance policies, retirement accounts, stock options, trusts, history of gifts to family members, loans, charitable contributions, charitable trusts, property, businesses, and income sources; and (C) goal information comprising retirement age and income goals and estate related goals.”

(*Walters* at ¶ 0012) (Emphasis added.)

Thus, *Walters* discloses receiving personal, financial, and goal information from a client and not “account preference information, describing the applicant’s preferences,” concerning various features of the financial product, as recited in independent claim 1. Indeed, *Walters* does not teach or suggest anywhere receiving preference information concerning a financial product. For at least this reason, *Walters* does not anticipate independent claim 1.

In addition, claim 1 recites, “recommending at least one first financial account product to the applicant based on the received account preference information.” As explained, *Walters* does not disclose “receiving account preference information concerning various features of the financial product.” Accordingly, *Walters* cannot, and does not, disclose “recommending at least one financial account product,” based on the

preference information. Instead, *Walters* determines financial products suitable for a client based on the client's own personal, financial, and goal information. This is different from the recommending step recited in claim 1.

The Examiner also asserts *Walters* teaches, "providing to the applicant a plurality of selectable options for further defining predetermined features of the recommended financial account product," as recited in claim 1. The Examiner is mistaken. First, because *Walters* does not disclose "receiving account preference information from the applicant, the account preference information describing the applicant's preferences concerning various features of the financial account product," the reference cannot disclose "further defining predetermined features of the recommended financial account product." And second, the cited portions (and any other portion) of *Walters* merely disclose report generating techniques and mechanisms for expected rates of return for a selected product (see e.g., *Walters* ¶¶ 0023-0025.) These features have no relationship with providing an applicant with selectable options for further defining predetermined features of a recommended financial product.

Moreover, claim 1 further recites, "receiving the applicant's selected options for the predetermined features of the recommended financial account product and customizing the recommended financial account product based on the applicant's selected options." The Examiner relies on paragraphs 0005-0018 and 0023-0025 from *Walters* as disclosing these features. (Office action at p. 2.) Again, the Examiner is incorrect. *Walters* discloses, at ¶ 0008, "computer tools that enable a customer to participate in substantially all aspects of the financial planning process from goal definition through financial product selection." According to *Walters*, customer's

participation may include “where the customer fully defines each cost constituent in a particular event, and each down payment and installment of each individual holding” (paragraph 0008).

Thus, *Walters* discloses a customer defining elements in a particular event, but does not disclose “customizing” a “recommended product.” Because *Walters* does not disclose “receiving account preference information from the applicant,” as recited in claim 1, the reference falls short of disclosing “customizing the recommended financial account product based on the applicant’s selected options,” where the financial account product is recommended based on the “account preference information,” as recited in claim 1.

For these additional reasons, *Walters* does not anticipate the claimed invention. Thus, the rejection of claim 1 under 35 U.S.C. § 102 is legally deficient and should be withdrawn and the claim allowed.

Independent claims 6 and 11, although of different scope, recite features similar to those of claim 1. As explained, the cited art does not support the rejection of claim 1. Accordingly, the cited art does not support the rejection of claims 6 and 10 for at least the same reasons set forth above in connection with claim 1.

Claims 2-5, 7-10, and 12-15 depend from independent claims 1, 6, and 11, respectively. As explained, the cited art fails to teach or suggest the recitations of claims 1, 6, and 11. As such, the cited art fails to support the rejection of claims 2-5, 7-10, and 12-15 for at least the same reasons set forth above for their respective independent claims. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by prior art. Therefore, Applicants

respectfully request that the Examiner withdraw the rejection of claims 1-15 under 35 U.S.C. § 102(a) and allow the claims. Additionally, newly added claims 16-21 depend from independent claims 1, 6, and 11. These claims are also allowable for at least the reasons set forth above. Moreover, the cited art fails to teach or suggest the recitations of claims 16-21.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: August 31, 2006

By: \_\_\_\_\_

A handwritten signature in black ink, appearing to read "Joseph E. Palys", is written over a horizontal line.

Joseph E. Palys  
Reg. No. 46,508